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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,736	08/17/2001	Weiping Shao	469290-76	3038
7590 05/04/2004				
CARELLA, BYRNE, BAIN, GILFILLAN, CECCHI, STEWART & OLSTEIN 6 Becker Farm Road Roseland, NJ 07068				
EXAMINER DAVIS, DEBORAH A				
ART UNIT		PAPER NUMBER		
1641				

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/931,736

Applicant(s)

SHAO, WEIPING

Examiner

Deborah A Davis

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 2-27-04 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 2-27-04. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: _____.

Claim(s) rejected: 1-4 and 8-18.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


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04/27/04

ATTACHMENT TO ADVISORY ACTION

Continuation of 5: does NOT place the application in condition for allowance

because:

Applicant's arguments are not found persuasive and therefore does not place this application in condition for allowance.: Applicant argues that Examiner failed to provide a motivation for obviousness rejection of Dorval et al in view of Cabilly et al for claims 1-4 and 8-18 and concludes that there is none for such a combination. In response, Examiner refers applicant to Final Office Action, page 3, last paragraph wherein a motivation is explained. Applicant argues that the reference of Cabilly et al solves a problem like the problem to be solved by applicant, but solves the problem by blocking the heavy chain constant region with the Protein A rather than using a chimeric antibody which must be prepared recombinantly. This argument is not found persuasive because Applicant is arguing limitations not found in the instant claims. Applicant argues that examiner should give patentable weight to the intended use of the product "blocked immunoglobulin" when said product claims are rejected under 103(a) obviousness, if the combination of references fails to solve the problem applicant is trying to solve. This argument is noted but not found persuasive. There is no requirement that the prior art must suggest that the claimed product will have the same or similar utility as that discovered by applicant in order to support a legal conclusion of obviousness. In *Re Dillion*, 919 F.2d 688, 696, 16 U.S.P.Q.2d 1897, 1904 (Fed. Cir. 1990) (in banc), cert. denied, 111 S. Ct. 1682 (1991). An obviousness rejection is proper under *Dillion*

so long as the prior art suggest a reason or provides motivation to make the claimed invention, even where the reason or motivation is based on a different one from that discovered by applicant. As the Dillion opinion notes, the applicant then has the burden and opportunity to present relevant evidence to overcome the rejection. Applicant argues that Examiner mentioned in the previous final rejection, other embodiments that were relied on in rejecting the claims, but failed to name those embodiment referred to. This argument is not found persuasive because Applicant was supplied a copy of the references used to reject the instant claims. In addition, Applicant is vague in reference to what embodiment needs to be pointed out in the references already at Applicant's disposal. Applicant argues that there is no motivation to combine because no one would think to use the Cabilly antibodies in the assay of Dorval et al because chimeric antibodies would be expensive and time consuming to make in that recombinant means are required. This argument is not found persuasive because the reference of Cabilly et al teaches that one advantage of the immunoglobulins antibodies are that they are easy to prepare (col 6, lines 65-66). Applicant argues that the reference of Dorval used protein A, but protein A will bind to the constant heavy chain region of the 1st antibody and block binding of Fc specific region of the 2nd antibody. Applicant further contends that the reference of Cabilly produced chimeric antibodies to avoid reactions at the Fc region and therefore the combination of the two references are disadvantaged. This argument is not found persuasive because the secondary reference of Cabilly was relied on for its teaching of the number of light and heavy variable regions in antibodies, how they can be altered, and its advantages. Further, Dorval et al also blocked the FC

region of the immunoglobulin to eliminate unwanted binding, therefore, the combination of Dorval and Cabilly are combinable. Applicant argues that there is not motivation to combine Sano and Cabilly because no one in the art would look to combine cabilly with Sano because there is only disadvantage of time and money in using Cabilly's chimeric antibodies versus any other antibody with an FC portion to attach DNA, and a variable region specific for the antigen to be detected. Although, Applicant contends, such a combination is technically achievable. This argument is not persuasive because the reference of Cabilly teaches altered immoglobulins with the ability to bind two antigens simultaneously, ease of preparation and high sensitivity (see col. 6, lines 35-68, and col. 15, lines 45-50). Arguments are not found persuasive for reasons aforementioned above and the previous final rejection..